## REMARKS

In response to the final Office Action mailed June 7, 2006, Applicant respectfully requests withdrawal of the finality of the Action and reconsideration of the new rejections.

### Request for Withdrawal of Finality

In the final Office Action ("Action") mailed on June 7, 2006, the Examiner asserts that "[b]ecause the applicant amends independent claims 1, and 8; different grounds of rejections are applied." [SIC]  However, Applicant notes that the amendments to claim 1 were clerical in nature and did not change the scope of the claimed subject matter. More specifically, claim 1 was amended to correct typographical and/or translation errors in order to more closely conform with U.S. patent practice.

In the previous Office Action, the Examiner rejected claim 1 under 35 U.S.C. § 102 as allegedly being anticipated by U.S. Patent No. 6, 148,090 to Narioka ("Narioka"). However, in the present Action, the Examiner now rejects claim 1 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Narioka in view of Microsoft Word.  More specifically, the Examiner now asserts that although Narioka fails to disclose extracting character data from displayed images, it would have been obvious to modify Narioka to include the "Find and Replace" functionality of Microsoft Word.

Original claim 1 recited "character data extracting means for extracting character string data of specific information on the specific point from among images displayed on the display control means."  Likewise, amended claim 1 recites "a character data

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extracting unit that extracts a character string including specific information regarding the specific point from among images displayed on the display." It is clear that Applicant's amendment to remove the "means" language did not necessitate the Examiner's new grounds of rejection. Accordingly, the finality of the present Action is improper. Therefore, Applicant respectfully requests withdrawal of the finality of the present Action.

## Request for Reconsideration

In paragraph 5 of the Action, the Examiner rejects claims 1-5 and 7-11 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,148,090 to Narioka ("Narioka"), in view of Microsoft Word ("Word"). Applicant respectfully traverses this rejection.

At the outset, Applicant notes that this rejection is improper inasmuch as the Examiner fails to provide any evidence that "Microsoft Word" is prior art under 35 U.S.C. § 103(a). Nowhere in the Action does the Examiner assert which version of Word he is relying on nor does he provide any evidence that the functionality relied on was available prior to the filing date of the present application. Accordingly, should the Examiner maintain this rejection in a future rejection, Applicant respectfully requests that the Examiner specify by version number and release date which release of Microsoft Office he is relying on.

In order to support a rejection under 35 U.S.C. § 103, the Examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of

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obviousness three criteria must be met. First, there must be some motivation to modify the cited reference. Second, there must be a reasonable expectation of success. Finally, the combination must teach each and every claimed element. In the present case, claims 1-5 and 7-11 are not rendered unpatentable by the combination of Narioka and Word because the Examiner fails to establish a *prima facie* case of obviousness as discussed below.

Independent claim 1 defines a navigation system. The system includes, *inter alia*, a communication unit that receives information on a specific point via a predetermined communication line; a display control unit that displays an image containing information on a specific point received by the communication unit on a display; a character data extracting unit that extracts a character string including specific information regarding the specific point from among images displayed on the display; and a route searching unit that searches routes based on conditions set in position information on the specific point received by the communication unit, and in the specific information extracted by the character data extracting unit.

Narioka discloses an apparatus and method for providing map information in image form. The method includes extracting crossing information from a map, generating images regarding points near the extracted crossings, and displaying the generated images near the crossings in a fixed sequence. However, Narioka fails to disclose a character data extracting unit that extracts a character string including

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specific information on the specific point from among images displayed on a display as claimed.

In rejecting claim 1, the Examiner asserts that Microsoft Word has performed "that well-known extracting function while editing a document." To support this assertion, the Examiner appears to point to the "Find and Replace" functionality provided by Word. Therefore, the Examiner concludes that it would have been obvious to one skilled in the art to modify Narioka's system "by adding above Microsoft Word function on finding a character string on displayed images for the convenience of a driver to copy exactly a character string having in a database with no typo error." This assertion is unfounded for the following reasons.

First, nowhere in the Action nor Narioka is there any evidence of the desirability of providing "cut and paste" and/or "find and replace" functionality in the system of Narioka. As discussed in § 2143.01 of the MPEP, the mere fact that a reference can be modified is not in and of itself sufficient to render the resultant modification obvious absent some evidence of the desirability of the proposed modification. In the present case, the Examiner fails to provide any evidence of the desirability of providing the added functionality suggested by the Examiner. Furthermore, nowhere in Narioka is there any disclosure or suggestion of extracting a character string from a displayed image. Accordingly, absent proper motivation to modify Narioka the rejection of claim 1 is improper.

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Second, even if one skilled in the art were motivated to modify Narioka to include the ability to cut and paste or find and replace a selected character string as suggested by the Examiner, which Applicant does not concede, the modification would still fail to render claim 1 unpatentable. Nowhere in Narioka is there any disclosure or suggestion of a route searching unit that searches routes based on conditions set in position information and specific information extracted by the character data extracting unit. Therefore, even if one skilled in the art were motivated to modify Narioka to include the ability to extract a character string, nowhere in Narioka is there any disclosure or suggestion of using the information contained in the extracted character string to search routes as claimed. Accordingly, independent claim 1 is patentable over the combination of Narioka and Word because the combination fails to disclose each and every claimed element.

Independent claim 8 defines a method of providing navigation assistance. The method includes, *inter alia*, receiving information on a specific point; displaying data regarding the specific point on a display; extracting a character string including detailed information regarding the specific point from the displayed data; searching routes based on position data associated with the specific point and the detailed information contained in the extracted character string; and displaying a route which meets conditions set in the position information and the detailed information. Therefore, claim 8 is patentable over the combination of Narioka and Word for at least those reasons presented above with respect to claim 1, i.e., the combination fails to disclose or

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suggest extracting a character string and searching for routes based on the position data and detailed information contained in the character string as claimed.

Claims 2-5, 7, and 9-11 variously depend from independent claims 1 and 8. Therefore, claims 2-5, 7, and 9-11 are patentable over the combination of Narioka and Word for at least those reasons presented above with respect to claims 1 and 8. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1-5 and 7-11 under 35 U.S.C. § 103(a).

In paragraph 6 of the Action, the Examiner rejects claims 6 and 11 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Narioka in view of U.S. Patent Application Publication No. US 2004/0036622 A1 to Dukach et al. ("Dukach"). Applicant respectfully traverses this rejection.

Claims 6 and 11 variously depend from independent claims 1 and 8 respectively. Therefore, claims 6 and 11 are patentable over Narioka for at least those reasons presented above with respect to claim 1. Dukach discloses a system for displaying messages on electronic displays, for example, mounted on vehicles. The system includes a GPS receiver so that a display's current geographical location can be sensed, and then used to select which messages are shown on the display. However, Dukach fails to overcome the deficiencies of Narioka.

Since Narioka and Dukach both fail to disclose or suggest a navigation system that includes a character data extracting unit and routing searching unit as claimed, the combination of these two references cannot possibly disclose or suggest said feature.

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Therefore, even if one skilled in the art were motivated to combine Narioka and Dukach, which Applicant does not concede, the combination would still fail to render claims 6 and 11 unpatentable because the combination fails to disclose each and every claimed element. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 6 and 11 under 35 U.S.C. § 103.

The application is in condition for allowance. Notice of same is earnestly solicited. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Penny Caudle (Reg. No. 46,607) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: September 6, 2006

Respectfully submitted,

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